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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,789	05/25/2001	Hassan Jomaa	JOMAA-1(PCT)	3331

25889 7590 09/23/2002

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EXAMINER

SAEED, KAMAL A

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 09/23/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,789

Applicant(s)

JOMAA, HASSAN

Examiner

Kamal A Saeed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-33 is/are allowed.
- 6) ☒ Claim(s) 34-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claims 14-26 are cancelled. Claims 27-40 are pending in this application.

Receipt is acknowledged of both Amendment B, filed March 26, 2002 and Supplemental Disclosure Statement, filed on June 17, 2002, which have been entered in the file.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 34-40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 35-40, the specification does not give any guidance as to the full range of preventing viral diseases using the instant claimed compound. In *In re Wands*, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. § 112, first paragraph, have been described. They are:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

Applicants are claiming a method of preventing viral diseases by administering a composition of the invention. Viral diseases include AIDS, hepatitis etc. It is well known in the

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art that AIDS is composed of many different diseases including pneumonia, Kaposi's sarcoma, Epstein Barr virus and various other opportunistic diseases caused by fungi, viruses, bacteria and protozoans. See, for example, *Acta Microbiol. Immun. Hung.* 41(1), 5-21 (1994), *Proc. Annu. Meet. Med. Sect. Am. Counc. Life Insurance*, 41-52 (1993). By using the term prevention of viral infectious diseases in the claim language, applicants are necessarily extending the prevention to these complications against which the invented compounds (or compositions) have not been demonstrated to be effective. As such, the specification fails to enable the skilled artisan to use the claimed compounds to prevent viral disease. In addition, there is no proof that the claimed compounds or compositions have ever been administered to a human or to an animal model. The obstacles to therapeutic approaches and vaccine development with regard to retroviruses associated with AIDS in humans are well documented in the literature. See, for example, Huff {*J. Med. Chem.* 34(8) 1991, p. 2305-2314} on page 2314. These obstacles include and are not limited to : 1) the extensive genomic diversity associated with HIV, particularly with respect to the gene encoding the envelope protein, 2) the fact that the modes of viral transmission include virus-infected mononuclear cells, which pass the infecting virus to other cells in a convert form, as well as via free virus transmission, 3) existence of a latent form of the virus, 4) the ability of the retrovirus to traverse the blood brain barrier and 5) the complexity and variation of the elaboration of the disease.

The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any vaccine or immunization treatment or any therapeutic regimen on its face. In order to provide proof of utility with regard to drugs and their uses, either clinical in vivo or in vitro data correlative to in vivo applicability

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or a combination of these can be used. However, the data must be such as to convince one of ordinary skill in the art that the proposed utility is sufficiently established as set forth in full, clear and exact terms in the disclosure. When the utility is directed to humans, the data must generally be clinical, however, adequate animal data would be acceptable in those instances wherein one of ordinary skill in the art would accept correlation to human utility. Thus, in order to rely on animal data, there must exist an art recognized animal model for testing purposes. In re Hartop, 311 F.2d 249, 135 USPQ 419 (CCPA 1962).

The rejection can be obviated by deleting the term "prevention".

Response to Amendments

Applicants' amendments in paper No. 7 filed June 17, 2002 have been considered and are found sufficient to overcome the rejection of claims 14, 15, 20, 24 and 25 (now amended claims 27, 28, 33, 37 and 38) under 35 U.S.C. 112, second paragraph and claims 22-26 (now amended claims 35-39) under 35 U.S.C. 101 for the reasons set forth in Paper No. 5.

Allowable Subject Matter

Claims 26-34 are allowable over the prior art.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal Saeed whose telephone number is (703) 308-4592. The examiner can normally be reached on Monday-Friday from 8:00 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308 4537. The unofficial fax phone for this group are (703) 308-4556 or 305-3592.


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When filing a FAX in Technology Center 1600, please indicate the Header (upper right) "Official" for papers that are to be entered into the file, and " Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-2286.

Kamal Saeed
September 19, 2002



Joseph McKane
Supervisory Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1